

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

**REMARKS/ARGUMENTS**

Claims 1, 2, 4, 5, 8, 9, 11, 12, 15, 21, 23, 25-30, 32, and 33 are pending. Claim 15 has been amended to correct grammar, and not to overcome any art. No claims have been added, canceled, or withdrawn.

In view of the following arguments, withdrawal of all outstanding objections and rejections to the pending claims is respectfully requested.

**Non-Statutory Claim Objections**

Claims 1, 2, 4, 5, 25, 15, and 27 stand objected to by the Examiner (no statutory basis for this rejection was provided by the Action). This rejection is traversed.

As a preliminary manner, the Action at page 2 provides only rationale for objecting claims 1 and 15, and fails to provide any rational for objecting to claims 2, 4, 5, 25, and 27. Since the Action does not provide rational for objecting to claims 2, 4, 5, 25, and 27, this section only addresses the objections to claims 1 and 15.

A fundamental principle contained in 35 U.S.C. 112, is that an Examiner "should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement". (See, MPEP §2173.02).

In addressing claims 1 and 15, the Action suggests that "in the storing step [...], that the preposition 'to' be changed to 'in'. It is important that the applicant employ commonly accepted terminology in the perspective of one of ordinary skill in the art." Applicant respectfully submits that the objected to language is commonly accepted terminology in the perspective of one of ordinary skill in the

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

art. Additionally, the objected to language satisfies the statutory requirements, and has been selected to particularly point out and claimed subject matter of the invention. In view of this, the Office is again reminded not to insist on its own preferences when other modes of expression selected by Applicant are appropriate.

With respect to claim 15, the Action suggests that "in the deriving step, [...] that a preposition "by" be added before 'using a portion ...'" Applicant has so amended claim 15.

In view of the above, Applicant trusts that the non-statutorily based objections to claims 1, 2, 4, 5, 25, 15, and 27 will be withdrawn.

**Claim Rejections Under 35 USC §112, First Paragraph**

Claims 1, 2, 4, 5, 25, 8, 9, 11, 12, 26, 15, 27, 21, 23, 28, 29, 30, 32, and 33 stand rejected under 35 USC §112, second paragraph as failing to comply with the written description requirement. This rejection is traversed.

In addressing claims 1, 8, 15, 21, and 29, the Action asserts that the claimed feature "deriving a unique identifier of the unique identifiers" is not described in the specification in the same way as it is in the claim. The examiner cannot find support for 'a unique identifier of the unique identifiers' in the specification." Applicant disagrees.

As a preliminary matter, nowhere does the MPEP state that the determining factor to comply with 35 USC §112, first paragraph written description requirement is that a claimed feature has to be "described in the specification in the same way as in the claim"; a standard that the Action on page 3 is seemingly applying in rejecting these claims on this statutory basis. If the examiner is

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

relying on the statutory language of “in such full, clear, concise, and *exact terms* as to enable any person skilled in the art ...” [emphasis added], it is respectfully submitted that this statutory language does not mean that a claimed feature has to be “described in the specification in the [exactly] the same way as in the claim”.

Rather, it is a fundamental aspect of patent law that “[a]n objective standard for determining compliance with the written description requirement is, does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. [...] [T]o satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” [MPEP §2163.01].

It is respectfully submitted that the subject specification clearly conveys to those skilled in the art that, as of the filing date sought, that Applicant was in possession of the claimed “a unique identifier” and “unique identifiers”. The specification clearly and plainly provides many references to the claimed “a unique identifier” and “unique identifiers”.

For example, the Summary section of the specification (page 2) clearly states “assigning data files to groups, processing each group to form corresponding processed images, associating each processed image with a unique identifier, generating a listing of unique identifiers, and storing the processed images and the listing of unique identifiers within a client device.” [Emphasis added]. Clearly, this rejected feature of a unique identifier of the unique identifiers” is supported by

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

the specification, and clearly conveys to those skilled in the art that, as of the filing date sought, that Applicant was in possession of the invention, and that the invention, in that context, is what is now being claimed. For at least these reasons, the claimed feature satisfies the 25 USC §112, first paragraph written description requirement.

The Action fails to provide any rational for rejecting claims 2, 4, 5, 25, 9, 11, 12, 26, 27, 21, 23, 28, 30, 32, and 33 under this statutory section of 35 USC §112, first paragraph.

Accordingly, and for the above reasons, the 35 USC §112, first paragraph rejection of claims 1, 2, 4, 5, 25, 8, 9, 11, 12, 26, 15, 27, 21, 23, 28, 29, 30, 32, and 33 is improper and should be withdrawn

**Claim Rejections Under 35 USC §112, Second Paragraph**

Claims 1, 2, 4, 5, 25, 8, 9, 11, 12, 26, 15, 27, 21, 23, 28, 29, 30, 32, and 33 stand rejected under 35 USC §112, second paragraph as being indefinite. This rejection is traversed.

In addressing claims 1, 8, 15, 21, and 29, the Action asserts that the feature “‘form one processed image of the processed images’ renders the claim indefinite because it is unclear whether the claim language means to ‘form one of the processed images’ or to ‘form one processed image, which is an image of the processed images’.” Applicant disagrees. The rejected terminology does not render the claimed feature indefinite, but instead, clearly particularly points out and distinctly claims the subject matter of the invention using conventional antecedent basis notation. The claim language conveys exactly what is meant to be conveyed in the claim: i.e., “to form one processed image of the processed

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

images”, which clearly means that “one processed image of the processed images” is formed.

Additionally, when addressing claims 1 and 8, the Action asserts that “in the deriving step, the claimed subject matter ‘a function of a portion of the one processed image’ renders the claim indefinite because it is unclear whether the claim language means ‘a function contained in a portion of the one processed image’ or ‘a function to be executed to produce a portion of the one processed image’”. Each of these conclusions by the Action with respect to the recited feature is unsupportable.

The cited feature “*as a function of* a portion of the one processed image” [emphasis added] is written in plain and clear English and means exactly what is stated. A person of ordinary skill in the art would clearly understand that the claimed “a function of a portion of the one processed image” is not “a function contained” in anything, and is not ‘a function to be executed to produce a portion of the one processed image’, as the Action queries. If it is helpful to the Examiner, consider the phrase “as a function of” something to be substantially equivalent to the phrase “based on” something, although Applicant has clearly chosen to use the former phraseology. A person of ordinary skill in the art would clearly understand either phrase to mean substantially the same thing.

The Action fails to provide any rational for rejecting claims 2, 4, 5, 25, 9, 11, 12, 26, 27, 21, 23, 28, 30, 32, and 33 under this statutory section of 35 USC §112, second paragraph.

Accordingly, and for the above reasons, the 35 USC §112, second paragraph rejection of claims 1, 2, 4, 5, 25, 8, 9, 11, 12, 26, 15, 27, 21, 23, 28, 29, 30, 32, and 33 is improper and should be withdrawn.

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

**Claim Rejections Under 35 USC §103(a)**

Claims 1, 2, 4, 5, 8, 9, 11, 12, 15, 21, 23, 25-30, 32, and 33 stand rejected under 35 USC §103(a) as being unpatentable over Stuart, in view of Spanbauer, in view of published EP Patent Application No. 01109486.9 published as EP 1,150,207 for inventors Suzuki et al ("Suzuki"), and further in view of Hollingsworth et al ("Hollingsworth"). This rejection is traversed.

As a preliminary matter, reasons why the reference group of Stuart, in view of Spanbauer, in view of Suzuki do not teach or suggest the features of claims 1, 2, 4, 5, 8, 8, 11, 12, 15, 21, 23, 25-30, 32, and 33 were already presented in the response filed on 11/11/03. Those arguments are not repeated verbatim herein but are incorporated by reference. The Office is urged to reconsider those arguments in view of the following additional arguments which clearly shown that the addition of Hollingsworth to the above cited combination does not cure the already discussed deficiencies of the reference group.

Nether *Stuart*, *Spanbauer*, *Suzuki*, and/or *Hollingsworth* disclose a method as recited in independent Claim 1 that includes "assigning each of a plurality of data files to one of a plurality of specific corresponding downloadable file groups", "generating processed images and a listing of unique identifiers as follows: for each downloadable file group: compressing together data files assigned to the downloadable file group to form one processed image of the processed images; and deriving a unique identifier of the unique identifiers for the one processed image, the unique identifier being derived as a function of a portion of the one processed image", "storing the processed images and the listing of unique identifiers to a source device", "comparing the listing of unique identifiers

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

with a current listing of unique identifiers in a client device", and "selectively sending processed images from the source device whose unique identifiers appear in the listing of unique identifiers but not in the current listing of unique identifiers in the client device".

More particularly, the cited references fail to disclose or even reasonably suggest "deriving a unique identifier of the unique identifiers for the one processed image, the unique identifier being derived as a function a portion of the one processed image". The Office Action admits at page 7 of the Action that this is not taught by *Stuart*, *Spanbauer*, and/or *Suzuki*. To provide this missing teaching, the Office Action relies on *Hollingsworth*. However, *Hollingsworth* does not cure the admitted deficiencies of the other references. Let's take a look at the description of *Hollingsworth* relied on by the Action:

*"A CDN provides all of its benefits by converting a package name from a name and version number meaningful to a developer into a Content-Derived Name that can be used to check library integrity and support secure removal retrieval. Since this name is probabilistically guaranteed not to conflict with other library names, it may be shared between different computers without fear of name duplication."*

Notice that the above cited text of *Hollingsworth* is completely silent on deriving CDNs (Content Derived Names) from a "portion" of anything. The Cambridge dictionary defines the term "portion" as "a part or share of something larger." Nowhere does *Hollingsworth* teach or suggest creating a CDN out of part or share of something larger. It is respectfully submitted that *Hollingsworth* does not teach or suggest creating a CDN out of part or share of something larger because *Hollingsworth* explicitly describes at page 1, section 1, paragraph 4, that "Content Derived Names are computed by hashing the contents of a file using a

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

secure hash". Nowhere does Hollingsworth teach or suggest that "contents of a file" is anything less than all contents of a file. Thus, a system *Stuart, Spanbauer, Suzuki*, and/or *Hollingsworth* may never "deriving a unique identifier of the unique identifiers for the one processed image, the unique identifier being derived as a function a portion of the one processed image", as claim 1 recites.

For this reason alone, the 35 USC §103(a) rejection of claim 1 is improper and should be withdrawn.

As an additional matter, the Action at page 7 asserts that "since the Content Derived Name is derived from the content of the package, which is equivalent to a processed image, it is obvious that it is derived from a portion of the package." This assertion is unsupportable. For the reasons already discussed above, the cited combination of references are completely silent on "deriving a unique identifier of the unique identifiers for the one processed image, the unique identifier being derived as a function a portion of the one processed image", as claim 1 recites. Thus, and without pointing to any specific teaching or suggestion to provide this missing feature of claim 1, the Action is seemingly relying on personal knowledge.

*"When a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." 37 CFR §1.104(d)(2).*

Accordingly, and if this rejection is maintained on a similar basis in a subsequent action, the Examiner is respectfully requested to supply such an affidavit to support this otherwise unsupported modification to Hollingsworth.



Appl. No. 09/756,052  
Response to November 15, 2004 Final Office action

**Claims 2, 4, 5, and 25** depend from claim 1 and recite additional features. At least for reasons of this dependency, claims 2, 4, 5, and 25 are allowable over the cited combination.

Accordingly, the 35 USC §103(a) rejection of claims 2, 4, 5, and 25 should be withdrawn.

**Claim 8** recites in part “assigning each of a plurality of data files to one of a plurality of specific corresponding downloadable file groups”, “generating processed images and a listing of unique identifiers as follows: for each downloadable file group, compressing together data files assigned to the file group to form a respective processed image of the processed images for the downloadable file group”, “deriving a unique identifier of the unique identifiers for the respective processed image, the unique identifier being derived as a function of one or more portions of the processed image”, and “storing the processed images and the listing of unique identifiers to a source device”. For the reasons already discussed above with respect to claim 1, *Stuart, Spanbauer, Suzuki et al.*, and/or *Hollingsworth* does not teach or suggest these recited features of claim 8.

Accordingly, the 35 USC §103(a) rejection of claim 8 is improper and should be withdrawn.

**Claims 9, 11, 12 and 26** depend from claim 8 and recite additional features. At least for reasons of this dependency on claim 8, claims 9, 11, 12 and 26 are allowable over the cited combination.

Accordingly, the 35 USC §103(a) rejection of claims 9, 11, 12 and 26 should be withdrawn.

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

**Claim 15** recites "generating processed images and a listing of unique identifiers by: assigning each of a plurality of data files to one of a plurality of specific corresponding downloadable file groups". And "for each downloadable file group: compressing together data files assigned to the downloadable file group to form one processed image of the processed images ; and deriving, using a portion of the one processed image, a unique identifier of the unique identifiers for the one processed image". "[S]toring the processed images and the listing of unique identifiers to the memory", and "comparing the listing of unique identifiers with a current listing of unique identifiers associated with a client device to identify processed images for providing to the client device." For the reasons already discussed above with respect to claim 1, *Stuart, Spanbauer, Suzuki et al*, and/or *Hollingsworth* does not teach or suggest these recited features of claim 15.

Accordingly, the 35 USC §103(a) rejection of claim 15 is improper and should be withdrawn.

**Claim 27** depends from claim 15 and recite additional features. At least for reasons of this dependency on claim 15, claim 27 is allowable over the cited combination.

Accordingly, the 35 USC §103(a) rejection of claim 27 is improper and should be withdrawn.

**Claim 21** recites in part "assign each of a plurality of server-based data files to one of a plurality of specific corresponding server-based downloadable file groups", and "generate processed images and a listing of unique identifiers as follows: for each server-based downloadable file group, the server device is configured to: compress together data files assigned to the server-based

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

downloadable file group to form one processed image of the processed images; and derive a unique identifier of the unique identifiers for the one processed image, the unique identifier being derived based on a portion of the processed image", as well as "selectively output the processed images and a latest listing of the unique identifiers over the network". For the reasons already discussed above with respect to claim 1, *Stuart*, *Spanbauer*, *Suzuki et al*, and/or *Hollingsworth* does not teach or suggest these recited features of claim 21.

Accordingly, the 35 USC §103(a) rejection of claim 21 is improper and should be withdrawn.

Claims 23 and 28 depend from claim 21, and recite additional features. At least for reasons of this dependency, claims 23 and 28 are allowable over the cited combination.

Accordingly, the 35 USC §103(a) rejection of claims 23 and 28 should be withdrawn.

Claim 29 recites "assigning each of a plurality of data files to one of a plurality of specific corresponding downloadable file groups", and "generating processed images and a listing of unique identifiers as follows: for each downloadable file group, compressing together data files assigned to the downloadable file group to form one processed image of the processed images" and "deriving a unique identifier of the unique identifiers for the one processed image, the unique identifier being derived using a portion of the processed image". For the reasons already discussed above with respect to claim 1, *Stuart*, *Spanbauer*, *Suzuki et al*, and/or *Hollingsworth* does not teach or suggest these recited features of claim 29.

Appl. No. 09/756,052

Response to November 15, 2004 Final Office action

Accordingly, the 35 USC §103(a) rejection of claim 29 is improper and should be withdrawn.

Claims 30, 32, and 33 depend from claim 29, and recite additional features. At least for reasons of this dependency, claims 30, 32, and 33 are allowable over the cited combination.

Accordingly, the 35 USC §103(a) rejection of claims 30, 32, and 33 should be withdrawn.

### Conclusion

The pending claims are in condition for allowance and action to that end is respectfully requested. Should any issue remain that prevents allowance of the application, the Office is encouraged to contact the undersigned prior or issuance of a subsequent Office action.

Respectfully Submitted,

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